

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action dated April 17, 2003. Claims 19, 22, 25, and 26 are pending in the Application. Applicant respectfully requests reconsideration of all pending claims and favorable action in this case.

Section 102 Rejections of Claims

The Examiner rejects Claims 19, 22, 25, and 26 under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent Number 4,623,965 issued to Wing (hereinafter "Wing"). This rejection is respectfully traversed for the following reasons.

Independent Claim 19 recites:

19. A portable check encoding device, comprising:
an input device operable to receive a check amount from a user and further operable to receive a payee name selected from a list of payee names by the user;
a memory operable to store and recall the list of payee names;
a display operable to display the check amount entered by the user and the list of payee names; and
a portable check printer operable to:
receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and
receive the selected payee name and print the selected payee name in a payee field on the check.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim." *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*). In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis original*)). Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. MPEP §2112

(citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis original*).

Using the preceding well-settled jurisprudence, it is clear that *Wing* fails to anticipate Independent Claim 19. For example, *Wing* fails to teach, suggest, or disclose a portable check printer operable to: receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and receive the selected payee name and print the selected payee name in a payee field on the check, as recited in Independent Claim 19. Applicant is somewhat perplexed by the presence of *Wing* because its deficiencies were identified long ago by the Examiner, as evidenced by the file history of the present Application.

The Examiner conceded: "*Wing* lacks the teaching of a check printer encoding the check amount in magnetic ink at a predetermined location." (See page 2 of Office Action of February 8, 2002.) In addition, without solicitation from Applicant, the Examiner explained: "*Wing/Schultz* lack the teaching of an input receiving a payee name selected from a list of payee names by the user, a memory operable to store and recall the list of payee names, and a display to display the list of payee names." (See page 2 of Office Action of February 8, 2002.)

In both cases, the Examiner was correct; *Wing* suffers from these shortcomings as well as many others that result in it not being related to the patentability of the pending claims. Moreover, nowhere in *Wing* is there even a remote teaching, suggestion, or disclosure of a portable check printer operable to: receive the check amount from the input device and encode the check amount in magnetic ink at a predetermined location on a check; and receive the selected payee name and print the selected payee name in a payee field on the check, as recited in Independent Claim 19. Thus, based on the Examiner's own admission, and the subject matter of *Wing*, it is impossible that such a reference anticipates Independent Claim 19. Additionally, based on the previous stance and reasoning of the Examiner, such a §102 rejection would be improper and devoid of any logic. For at least these reasons, Independent Claim 19 is patentable over *Wing* and notice to this effect is respectfully requested.

Claims 22, 25, and 26 depend from Independent Claim 19 and add a limitation that further distinguishes them from the prior art of record. Therefore Claims 22, 25, and 26 are

allowable, for example, for the same reasons as identified above. Notice to this effect is respectfully requested.

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of Claims 19, 22, 25, and 26.

The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 05-0765 of Electronic Data Systems Corporation.

Respectfully submitted,

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